

### **REMARKS**

Claims 1-9 remain pending in the application and claims 5-9 stand rejected.

Claims 1-4 were withdrawn from consideration in view of a Restriction Requirement.

Applicant respectfully requests reconsideration in view of the following remarks.

#### **Affirmation of Elected Claims**

The claims have been restricted to the following inventions, indicated by the Examiner:

- I. Claims 1-4 drawn to an automotive interior trim assembly.
- II. Claims 5-9 drawn to a method of forming an automotive interior trim.

Applicant hereby affirms the election of claims 5-9 for examination on the merits, in accordance with the telephone conversation with Applicant's representative, David W. Dorton, on March 23, 2006.

#### **Claims Rejected Under 35 U.S.C. §103**

Claims 5-9 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Application No. 2003/0184064 to Hier et al. in view of U.S. Patent No. 6,627,134 to Thomson. Claim 5 is the only independent claim of this rejected group and is directed to a method of forming an automotive interior trim assembly in a two-shot molding operation, comprising:

injecting a first material to form a substrate member during the first shot of the molding operation; and

co-injecting second and third materials onto the substrate member to form a cover member on the substrate member during the second shot of the molding operation.

To establish a *prima facie* case of obviousness, there must be some suggestion or motivation to modify references or to combine reference teachings to arrive at the claimed invention; there must be a reasonable expectation of success; and the references must teach or suggest all of the claimed limitations. The mere fact that the elements of a claimed invention are known in the art is not, of itself, sufficient basis for an obviousness rejection. In re Katzab, 55 USPQ.2d 1313 (Fed. Cir. 2000); MPEP §2143.01. Rather, there must be some motivation, teaching or suggestion in the prior art to make the combination, either explicitly or implicitly. Id. "The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification." In re Fritch, 23 USPQ.2d 1780, 1783-84 (Fed. Cir. 1992). "It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious." Fritch at 1784.

Applicant respectfully traverses the rejection of claim 5 because Hier '064 does not teach or suggest each and every element of claim 5, and because no suggestion or motivation to co-inject second and third materials onto a substrate member during the second shot of a two-shot molding operation is found in the references of record. Specifically, Hier '064 is directed to a two-shot method of integrally forming an air bag door 14 in a retainer portion 12 of an instrument panel 10. The door is molded from a less rigid material to close off an opening 20 that has been left in the retainer 12, so that the retainer 12 circumscribes the door 14. (See Hier '064 at paragraphs 0020 and 0025.) Skin layer 232, indicated by the Examiner, is not described in Hier '064 as being

molded over the retainer 12, let alone in a co-injection process.

While Thomson '134 is directed to an apparatus for co-injecting materials, there is no teaching or suggestion to co-inject second and third materials during a two-shot-molding process to form a cover layer over a substrate member that was formed during the first shot of the process. Nevertheless, the Examiner states that it would have been "obvious to form a cover composite, as taught by Thomson, and combine it with a substrate in the method of Hier, and [one] would have been motivated to do so for the simplification of forming a skin/backing composite without the additional step of inserting a component into the mold interim to the cycle." (Office Action at page 4.) The basis of this rejection amounts to a hindsight analysis that uses Applicant's own disclosure to piece together the instrument panel of Hier '064 and the co-injection process of Thomson '134. Neither Hier '064 nor Thomson '134 recognize, teach, or suggest the desirability of using a co-injection of second and third materials during the second shot of a two-shot molding operation to form an automotive interior trim assembly, claimed in the present application. Because hindsight-based reconstruction of a claimed invention is forbidden by current law, Applicant respectfully requests that the rejection of claim 1 be withdrawn.

Claims 6-9 each depend from claim 5 and are therefore in condition for allowance for at least the reasons discussed above with respect to claim 5. Accordingly, Applicant respectfully request that the rejections of claims 6-9 be withdrawn.

**Conclusion**

In view of the foregoing remarks set forth herein, Applicant believes this case is in condition for allowance and respectfully requests allowance of the pending claims. If the Examiner believes any issue requires further discussion, the Examiner is respectfully invited to telephone the undersigned attorney so that the matter may be promptly resolved. The Examiner's prompt attention to this matter is appreciated.

Applicant does not believe that any fees are due in connection with this submission. However, if any additional fees are necessary to complete this communication, the Commissioner may consider this to be a request for such and charge any necessary fees to Deposit Account No. 23-3000.

Respectfully submitted,

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